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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,859	06/14/2006	Masahide Kondo	292456US0PCT	5965
22850 7590 06/02/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER MARTINEZ, BRITTANY M				
ART UNIT 1793		PAPER NUMBER		
NOTIFICATION DATE 06/02/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/582,859

Applicant(s)

KONDO ET AL.

Examiner

BRITTANY M. MARTINEZ

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on February 19, 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/ISD)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 3/24/2008

DETAILED ACTION

Status of Application

Applicant's arguments/remarks and amendments filed on February 19, 2008, have been carefully considered. **Claims 1-5** are pending in this application, with **Claims 1-3** examined and **Claims 4-5** withdrawn in view of the restriction requirement made August 22, 2007.

Title

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: *Method for Producing Catalyst for Production of Unsaturated Aldehyde and Unsaturated Carboxylic Acid.*

Specification

2. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The wording of much of the specification is unclear and utilizes poor grammar and spelling. In general, it appears as if the application was not proofread. *Applicants are strongly encouraged to review the entire application for these mistakes, as well as other spelling and grammar errors.* Appropriate correction is required. The substitute

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specification filed must be accompanied by a statement that it contains no new matter.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in the prior Office Action.

3. **Claims 1-3** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al. (WO 02076611) in view of the instant specification), as applied in the prior Office Action.

Double Patenting

1. **Claim 1** is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5-7 and 17-18 of copending Application No. 10/473,255, as applied in the prior Office Action.

2. **Claim 1** is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 14 of copending Application No. 10/504,143, as applied in the prior Office Action.

Response to Amendments

Applicant's amendments, filed February 19, 2008, with respect to the Abstract and claims have been fully considered and are accepted. The

objections to the Abstract and claims, filed October 19, 2007, and the 35 U.S.C. § 112 claim rejections, filed October 19, 2007, have been withdrawn. It is noted that Applicant did not amend the instant title or specification. Thus, the objections to the instant title and specification, filed October 19, 2007, are maintained.

Response to Arguments

1. Applicant's arguments regarding the Claim Rejections under 35 U.S.C. § 103, filed February 19, 2008, have been fully considered but they are not persuasive.

With regard to Applicant's arguments that "Kondo neither teaches nor suggests using an organic binder component containing compounds having the required viscosities, or that using such an organic binder component would result in catalysts having improved activity and selectivity properties. Thus, Kondo neither teaches nor suggests the claimed processes" and "The Office Action bases the pending § 103 rejection on the assumption that Kondo's materials inherently possess the required viscosity characteristics. However, such an assumption is not well-founded. For example, as can be seen in example 1 of the present application, compounds can have widely varying viscosity properties. In example 1, two different hydroxypropylmethylcellulose compounds having different viscosity properties are used. Thus, merely because Kondo discloses two compounds does not mean that Kondo discloses two compounds having the required viscosities or any benefits from using the two

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compounds having the required viscosities [sic]. Stated another way, one skilled in the art, following Kondo, would not be led to using two different compounds having the required viscosity properties --- Kondo is silent concerning the use of compounds having the required viscosities," Examiner respectfully disagrees.

Applicant discloses:

"...the organic binder is not particularly limited, a cellulose derivative such as methyl cellulose, ethyl cellulose, carboxymethyl cellulose, sodium carboxymethyl cellulose, hydroxyethyl cellulose, hydroxypropyl cellulose, hydroxypropylmethyl cellulose, hydroxyethylmethyl cellulose, hydroxybutylmethyl cellulose or ethylhydroxyethyl cellulose, or a water soluble or water dispersible synthetic polymer compound such as polyvinyl alcohol, or a β -1,3-glucan such as curdlan, laminaran, paramylon, callose, pachyman or scleroglucan can be exemplified.

As the kind of the high-viscosity organic binder, methyl cellulose, hydroxypropylmethyl cellulose and hydroxyethylmethyl cellulose are especially preferable...

As the kind of the low-viscosity organic binder, methyl cellulose, hydroxypropylmethyl cellulose and hydroxyethylmethyl cellulose, curdlan and paramylon are especially preferable" (S. 10, 0031, and 11, 0031-0033).

Kondo teaches that "...it is more preferable that said kneaded material be obtained by adding a [beta]-1,3-glucan, a cellulose derivative and a liquid to the catalyst particles..." (Kondo, 0008). Further, "...it is preferable that said [beta]-

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1,3-glucan be curdlan" (Kondo, 0012) and the "...cellulose derivative used in combination with the [beta]-1,3-glucan comprise one or more members selected from the group consisting of methylcellulose, carboxymethylcellulose, hydroxypropyl methylcellulose and hydroxyethyl methylcellulose" (Kondo, 0012). Kondo discloses methylcellulose, ethylcellulose, carboxymethylcellulose, carboxymethylcellulose sodium, hydroxyethyl cellulose, hydroxypropyl cellulose, hydroxypropyl methylcellulose, hydroxyethyl methylcellulose, hydroxybutyl methylcellulose and ethylhydroxyethyl cellulose (Kondo, 0029) to be specific example of cellulose derivatives that may be used as molding aids, and curdlan, laminaran, paramylon, callose, pachyman and scleroglucan (Kondo, 0032) as specific examples of β -1,3-glucans that can be used. The viscosity of a 1% water solution or dispersion at 20°C of a particular organic binder is inherent, thus it would have been obvious in view of Kondo and/or the instant specification to a person of ordinary skill in the art to modify the process disclosed by Kondo with "...at least a high-viscosity organic binder having a viscosity (of its 1% water solution or dispersion at 20°C) of from 5,000 mPa·s to 25,000 mPa·s and a low-viscosity organic binder having a viscosity (of its 1% water solution or dispersion at 20°C) of from 10 mPa·s to less than 5,000 mPa·s" (Claim 1, lines 7-10) as taught by the instant in order to allow for a catalyst having high catalytic activity and high selectivity for an unsaturated aldehyde and an unsaturated carboxylic acid (Kondo, 0031), improved moldability of the kneaded catalyst material (Kondo, 0036), and the development of "more desirable pores" (Kondo, 0046) in the final extrusion-molded catalyst. Further, Applicant has not proven that two of

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the same organic binders, such as the hydroxypropylmethylcellulose of Example 1, may have differing viscosity when measured with a 1% by mass water solution or dispersion of the binder at 20°C.

Conclusion

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **BRITTANY M. MARTINEZ** whose telephone number is (571) 270-3586. The examiner can normally be reached on Monday-Thursday 7:00AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on (571) 272-1358.

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The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Wayne Langel/
Primary Examiner, Art Unit 1793

BMM

/Brittany M Martinez/
Examiner, Art Unit 1793